

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Rabindranath Dutta		
Assignee:	International Business Machines Corporation		
Title:	Method and System in Electronic Commerce for Uniquely Identifying Products to Improve Reliability and Confidence in Transactions Initiated Online		
Serial No.:	09/732,482	Filing Date:	December 7, 2000
Examiner:	Harish T. Dass	Group Art Unit:	3628
Docket No.:	AUS920000856US1	Customer No.:	65362

Austin, Texas
November 20, 2006

COMMISSIONER FOR PATENTS
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**PRE-APPEAL BRIEF REQUEST FOR REVIEW
AND STATEMENT OF REASONS**

Dear Sir:

Pursuant to a Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. § 1.137(b) filed concurrently herewith, Applicant requests review of the Final Rejection dated December 20, 2004 in the above-identified application. No amendments are being filed with the request. This request is being filed with a Notice of Appeal. The following sets forth a succinct, concise, and focused set of arguments for which the review is being requested.

CLAIM STATUS

Claims 1-8, 10, 11, 14-21, 23, 24, 27-34, 36 and 37 are pending in the application. Claims 1-2, 6-7, 10, 11, 14-15, 19-21, 23, 24, 27-28, 32-34, 36 and 37 stand rejected under Woolston, U.S. Patent No. 6,202,051, in view of Eliason, "Online Business Computer

Applications,” (2nd ed. 1987).¹ Claims 3-5 stand rejected under Woolston and Eliason and further in view of Shkedy, U.S. Patent No. 6,260,024.

REMARKS

The following remarks provide Applicant’s position regarding how the claims distinguish over the art of record. As explained below, none of the cited references disclose or suggest the claimed transaction processing system whereby a physical transaction tag sent to a seller is associated with the transaction goods to be sold and then photographed to form a digital image which shows both the goods and the physical tag, and which is sent through the computer network to a viewer.

The present invention relates in part to a system for facilitating trustworthy electronic commerce by providing a methodology for uniquely identifying a product offered for sale online so as to improve the trustworthiness of a purchase that was initiated electronically. In the system, a product for sale in an online auction has a unique, tamper-resistant, physical transaction tag applied to the product. Thereafter, the product is photographed as a digital image in such a way that the physical transaction tag is visible in the digital image of the photographed product. The image of the product is subsequently sent to a buyer in some manner (e.g., by being posted by the seller as part of an online auction process that the buyer is viewing). When the product is purchased and received by a buyer with the tamper-resistant tag physically attached to the product, the buyer then has increased confidence both before and during the exchange of the product that the product is identical to the product that was described via the image of the product. In particular, each pending claim includes the recitation of “the transaction tag being visible within the digital image.” *See*, independent claims 1, 10, 14, 23, 27 and 36.

In rejecting the claims, the Examiner asserts that Woolston discloses a system for auctioning a uniquely identified item over an electronic network substantially as recited in claim 1. However, the Examiner concedes that Woolston does not disclose having the physical transaction tag be visible in the digital image of the product being sold. *See*, Final Office Action.

¹ There appeared to be some confusion in the Final Office Action, where the Examiner stated that “Claims 1-2, 6-39 are rejected under 35 U.S.C. 103(a)” (Final Office Action, p. 2), even though some of these claims were cancelled in Applicant’s previous amendment. In addition, the Examiner set forth an express rejection of claim 9 (Final Office Action, p. 5), even though claim 9 had been cancelled. For purposes of this submission, Applicant’s arguments are applied to the pending claims 1-8, 10, 11, 14-21, 23, 24, 27-34, 36 and 37.

p. 3 (“Woolston, explicitly, does not disclose wherein the transaction tag is a physical tag and transaction tag being visible within digital image.”).

To remedy this admitted deficiency in Woolston, the Examiner invokes *unsubstantiated* examples of product shipments, digital driver licenses and ID badges to show that it would be obvious “to affix a digital image of a product with product information imprinted on the box.” Final Office Action, p. 3 (“It is well know (sic) that in the United State (sic) many of the products shipped include a bar code, item name, and specification with picture imprinted on the side of a box and an invoice affixed to the box describing what item is shipped and where the buyer can check without opening the box.”). The Examiner “additionally” invokes Eliason’s disclosure of including packing slips with a product shipment to show that it would be obvious “to show what item is included and this slip may be affixed on the side of the box as discloses (sic) by US shipping procedure to check the content of the delivered item without opening the box.” Final Office Action, pp. 3-4.

Putting aside for the moment the Examiner’s improper reliance on unsubstantiated and non-specific examples of what was allegedly “well known,” Applicant respectfully submits that none of the cited examples or disclosures, alone or in combination, disclose that a “physical transaction tag” and the associated transaction goods are photographed to form a digital image showing both the goods and the physical tag as variously recited in the pending claims. Nor do any of the references, alone or in combination, disclose generating a physical transaction tag by an online service which is sent *to the seller*. See, e.g., claim 1 (“sending the transaction tag to the seller”). By separately generating and sending the physical transaction tag to the seller, a digital image can be generated which shows the tag with the product, allowing the buyer to verify that the delivered product is the same product that was viewed online. Accordingly, claims 1-2, 6-7, 10, 11, 14-15, 19-21, 23, 24, 27-28, 32-34, 36 and 37 are allowable over Woolston and Eliason since neither reference, alone or in combination, discloses receiving a **digital image in which both the goods and the physical transaction tag are visible**. In addition, claims 3-5, 16-18 and 29-31 are also allowable since none of the cited Woolston, Eliason and Shkedy references, alone or in combination, disclose the requirement in these claims of receiving a **digital image in which both the goods and the physical transaction tag are visible**.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA

1974); In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Where a rejection is based on the assertion that multiple prior art references would be combined to produce the claimed invention, the fact finder must determine “[w]hat the prior art teaches, whether it teaches away from the claimed invention, and whether it motivates a combination of teachings from different references.” Dystar Textilfarben GMBH v. C.H. Patrick Co., No. 06-1088, p. 7 (Fed. Cir. 2006), *citing* In re Fulton, 391 F.3d 1195, 1199-1200 (Fed. Cir. 2004). Applicant respectfully submits that the Examiner has improperly combined the cited references. Where, as here, there is no motivation to combine explicitly taught by the prior art references, the “evidence” of motivation to combine may be provided as an explanation of the well-known principle or problem-solving strategy to be applied, but in any event *requires* some evidence of any common knowledge and common sense, above and beyond mere assumption. Dystar Textilfarben, pp. 17-20. The Examiner’s invocation of the Eliason disclosure is done without even attempting to make the required Dystar evidentiary showing of a motivation to combine the Woolston and Eliason references. Instead, the Examiner simply recites the claim language requirements of claim 1 (Final Office Action, pp. 3-4), a classic sign of improper hindsight reconstruction. In this regard, it must be recognized that hindsight reconstruction of claims based on disparate aspects of the prior art may not be employed as a valid basis for the rejection of those claims. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303, 312-313 (Fed. Cir. 1983); Panduit Corp. v. Dennison Manufacturing Co., 1 USPQ2d 1593, 1595-1596 (Fed. Cir. 1987). Furthermore, an obviousness determination requires that the invention *as a whole* would have been obvious to a person having ordinary skill in the art, and not simply some individual portion of the claimed invention. Connell v. Sears Roebuck & Co., 220 USPQ 193 (Fed. Cir. 1983). Accordingly, Applicant submits that all pending claims are allowable since none of the cited Woolston, Eliason or Shkedy references discloses using a digital image which shows an image of the goods being sold and a physical transaction tag associated with those goods, and in addition the Examiner has failed to provide any evidence that the references would be combined in the first place.

CONCLUSION

For at least the foregoing reasons, Applicant submits that the rejection of the pending claims under 35 U.S.C. §103(a) should be removed and these claims should be allowed. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the examiner is requested to telephone the undersigned at (512) 338-9100.

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Respectfully submitted,

/Michael Rocco Cannatti/

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